

REMARKS

Claims 2, 6, 8, 11 and 12 are canceled (claims 4, 9 and 10 were previously canceled). Claims 1, 3, 7, 13, 14 and 15 have been amended. Claims 1, 3, 5, 7, 13, 14 and 15 remain in the application. Support for the amendments to the claims is identified herein. No new matter has been added. Reconsideration and allowance of the application is respectfully requested.

Rejection under 35 U.S.C. §112

Claims 1 to 3, 5 to 8, and 11 to 15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 2, 6, 8, 11 and 12, the same have been canceled herein, thus rendering the rejection thereof now moot.

With respect to claim 1, applicants respectfully traverse this rejection for at least the following reason. By this amendment, claim 1 has been amended, to recite in part "organosilane compounds that contain an organic, polymerizable substituent, wherein the organosilane compounds that contain the organic, polymerizable substituent consist of 3-glycidoxypropyl trimethoxysilane, methacryloxypropyl trimethoxysilane and vinyl trimethoxysilane" (supported in the original specification at least on page 3, line 32 through page 4, line 5). Thus, claim 1 as amended more clearly points out and distinctly claims the subject matter which applicant regards as the invention. Accordingly, the §112, second paragraph, rejection with respect to claim 1 is now believed overcome. Withdrawal of the rejection is respectfully requested.

With respect to claims 3, 5 and 7, the same depend from and add further limitation, in a patentable sense, to allowable independent claim 1. Accordingly, the §112, second paragraph, rejection with respect to claims 3, 5 and 7 is now believed overcome. Withdrawal of the rejection is respectfully requested.

With respect to claim 13, applicants respectfully traverse this rejection for at least the following reason. By this amendment, claim 13 has been amended, to recite in part "organosilane compounds that contain an organic, polymerizable substituent, wherein the organosilane compounds that contain the organic, polymerizable substituent consist of 3-glycidoxypropyl trimethoxysilane, methacryloxypropyl trimethoxysilane and vinyl trimethoxysilane" (supported in the original specification at least on page 3, line 32 through page 4, line 5). Thus, claim 13 as amended more clearly points out and distinctly claims the subject matter which applicant regards as the invention. Accordingly, the §112, second paragraph, rejection with respect to claim 13 is now believed overcome. Withdrawal of the rejection is respectfully requested.

With respect to claims 14 and 15, the same depend from and add further limitation, in a patentable sense, to allowable independent claim 13. Accordingly, the §112, second paragraph, rejection with respect to claims 14 and 15 is now believed overcome. Withdrawal of the rejection is respectfully requested.

Claims 1 to 3, 5 to 8, and 11 to 15 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

With respect to claims 2, 6, 8, 11 and 12, the same have been canceled herein, thus rendering the rejection thereof now moot.

With respect to claims 1 and 13, applicants respectfully traverse this rejection for at least the following reason. The subject matter of claims 1 and 13, as presented herein, is described in the specification at least on page 3, line 32 through page 4, line 5. Accordingly, the §112, first paragraph, rejection with respect to claims 1 and 13, as well as with respect to dependent claims (3, 5 and 7) and (14-15), respectively, is now believed overcome. Withdrawal of the rejection is respectfully requested.

Claims 1 to 3, 5 to 8, and 11 to 15 were objected to for the following informalities: The word "methyltromethoxysilane" is misspelled. In addition, in claim 6, "dimethylmalonoc" is misspelled.

With respect to claims 2, 6, 8, 11 and 12, the same have been canceled herein, thus rendering the objection thereof now moot.

With respect to claims 1 and 13, applicants respectfully traverse this rejection for at least the following reason. Claims 1 and 13 have been amended to include the correct spelling for "methyltrimethoxysilane." Accordingly, the objection with respect to claims 1 and 13, as well as with respect to dependent claims (3, 5 and 7) and (14-15), respectively, is now believed overcome. Withdrawal of the objection is respectfully requested.

Claims 2, 14 and 15 were objected to under 37 CFR 1.75(c), as being improper dependent form for failing to further limit the subject matter of a previous claim.

With respect to claim 2, the same has been canceled herein, thus rendering the objection thereof now moot.

With respect to claims 14 and 15, applicants respectfully traverse this rejection for at least the following reason. Claims 14 and 15 have been amended into proper dependent form by further limiting the subject matter of claim 13. Accordingly, the objection with respect to claims 14 and 15 is now believed overcome. Withdrawal of the objection is respectfully requested.

Rejection under 35 U.S.C. §102

Claim 1 recites a medical apparatus comprising at least one surface which is at least partially coated with a hydrolytically condensed organosilane sol-gel composition,

wherein the organosilane sol-gel composition comprises a mixture of tetraethoxysilane, methyltrimethoxysilane, and organosilane compounds that contain an organic, polymerizable substituent, wherein the organosilane compounds that contain the organic, polymerizable substituent consist of 3-glycidoxypopyl trimethoxysilane, methacryloxypropyl trimethoxysilane and vinyl trimethoxysilane, and wherein the organosilane sol-gel composition is further formed from dimethylmalonic acid.

Support for the amendment to claim 1 (as well as for amendment to claims 13) can be found in the specification at least on page 3, line 32 through page 4, line 5; and on page 4, line 32.

Claims 1 to 3, 5, 6, 8, 11 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Havey et al (US 6,001,163).

With respect to claims 2, 6, 8 and 11, the same have been canceled herein, thus rendering the rejection thereof now moot.

With respect to claim 1, Applicants respectfully traverse this rejection for at least the following reasons.

The PTO provides in MPEP § 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, with respect to claim 1 as currently amended, to sustain this rejection the **Havey et al.** reference must contain all of the above claimed elements of the

respective claims. However, contrary to the examiner's position that all elements are disclosed in the **Havey et al.** reference, the latter reference does not disclose "... wherein the *organosilane sol-gel composition* comprises a mixture ... , and organosilane compounds that contain an organic, polymerizable substituent, ... that ... consist of 3-glycidoxypopyl trimethoxysilane, methacryloxypopyl trimethoxysilane and vinyl trimethoxysilane, *and* wherein the organosilane sol-gel composition is further formed from *dimethylmalonic acid*" as is claimed in claim 1. Therefore, the rejection is not supported by the **Havey et al.** reference and should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 3 and 5 depend from and further limit allowable independent claim 1 and therefore are allowable as well. Withdrawal of the rejection and an early formal notice of allowability is respectfully requested.

Claim 13 has been amended in a similar manner to that of amended claim 1. For at least the same reasons as presented with respect to claim 1 above, claim 13 is believed allowable. Accordingly, withdrawal of the rejection and an early formal notice of allowability is respectfully requested.

Rejection under 35 U.S.C. §103

Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Havey et al (US 6,001,163). With respect to claims 14 and 15, the same depend from and further limit, in a patentable sense, allowable independent claim 1 and thus are allowable as well. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §102

Claims 1 to 3, 5, 6, 8, 11 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Schachter (US 2005/0008763).

With respect to claims 2, 6, 8 and 11, the same have been canceled herein, thus

rendering the rejection thereof now moot.

With respect to claim 1, Applicants respectfully traverse this rejection for at least the following reasons.

The PTO provides in MPEP § 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, with respect to claim 1 as currently amended, to sustain this rejection the **Schachter** reference must contain all of the above claimed elements of the respective claims. However, contrary to the examiner's position that all elements are disclosed in the **Schachter** reference, the latter reference does not disclose "... wherein the *organosilane sol-gel composition* comprises a mixture ... , and organosilane compounds that contain an organic, polymerizable substituent, ... that ... consist of 3-glycidoxypopyl trimethoxysilane, methacryloxypopyl trimethoxysilane and vinyl trimethoxysilane, *and* wherein the organosilane sol-gel composition is further formed from *dimethylmalonic acid*" as is claimed in claim 1. Therefore, the rejection is not supported by the **Schachter** reference and should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 3 and 5 depend from and further limit allowable independent claim 1 and therefore are allowable as well. Withdrawal of the rejection and an early formal notice of allowability is respectfully requested.

Claim 13 has been amended in a similar manner to that of amended claim 1. For at least the same reasons as presented with respect to claim 1 above, claim 13 is believed allowable. Accordingly, withdrawal of the rejection and an early formal notice of allowability is respectfully requested.

Rejection under 35 U.S.C. §103

Claims 7 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schachter (US 2005/0008763).

With respect to claim 12, the same has been canceled herein, thus rendering the rejection thereof now moot.

With respect to claim 7, the same depends from and further limits, in a patentable sense, allowable independent claim 1 and thus is allowable as well. Withdrawal of the rejection is respectfully requested.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schachter (US 2005/0008763) as applied to claim 1, further in view of Shoup et al. (US 2003/0157344).

With respect to claim 6, the same has been canceled herein, thus rendering the rejection thereof now moot.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1 and 13 are in condition for allowance. Dependent claims 3, 5 and 7 depend from allowable independent claim 1, and are thus also allowable. Dependent claims 14 and 15 depend from allowable independent claim 13 and are thus also allowable.

Amendments herein are fully supported by the original specification and drawings as discussed herein; therefore, no new matter is introduced. Issuance of an early formal notice of allowance of claims 1, 3, 5, 7, 13, 14 and 15 is requested.

Respectfully submitted,



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